Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEYUKI KATAYAMA

Appeal No. 2001-1467
Application No. 08/687,039

HEARD: July 9, 2002[1]

Before HAIRSTON, JERRY SMITH, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 2-15. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The appellant's invention is a radio pager that generate alert tones corresponding to musical notes coded in a paging signal. A conventional paging signal sent from a base station to a radio pager includes an address and a message. The pager compares the address in the received signal with its own address; if the two

[1] The examiner declined an invitation to explain the rejections at the oral hearing.

codes coincide, the pager alerts its user of the receipt of a message by outputting a sound or vibration in a pattern stored in the pager. If different sound or vibration patterns are stored in the pager, the base station adds a code designating one of the patterns to the paging signal, and the pager selects and outputs the corresponding pattern.

Because the fixed sound and vibration patterns must be stored in the pager, the number of such patterns is limited by the storage capacity of the pager. Accordingly, protests the appellant, conventional pagers requiring a large storage capacity and having a limited choice of user alerts. (Spec. at 2).

In contrast, the message portion of the appellant's paging signal includes musical data. Based on melody start and end symbols therein, his radio pager separates the message portion into textual data and the musical data. It then generates melody frequencies corresponding to the musical data, modulates the melody frequencies to output a melody, and drives a speaker therewith. With this configuration, asserts the appellant, the pager can output alert tones in a variety of patterns. (*Id.* at 13-14.) He adds that the pager does not require a memory to store different patterns of alert tones. (*Id.* at 14.)

A further understanding of the invention can be achieved by reading the following claim:

> 4. A radio pager for receiving from a base station a paging signal including an address code group and a message code group, said message code group including message data and musical note data, and displaying, upon a coincidence of an address code of said address code group with an address code assigned to said radio pager, a message on an LCD while causing a speaker to sound an alert tone, said radio pager comprising:
>
> a controller which separates the paging signal into the address code group and the message code group, and separates the message code group into the message data and the musical note data; and
>
> a melody generator which generates said alert tone in response to said coincidence, said alert tone corresponding to, and reproducing at least a portion of the musical note data separated by said controller from the message code group;
>
> said controller further comprising a message conversion table for storing a plurality of first frequencies, each corresponding to a respective musical note data, and a plurality of first musical notes, said first musical notes respectively corresponding to said plurality of said first frequencies.

Claims 2-6 stand rejected under 35 U.S.C. § 103(a) as obvious over International Publication No. W0 96/06417 ("Dalvi") in view of Thomas C. Bartee, *Data Communications, Networks, and Systems* (1991) ("Bartee") further in view of U.S. Patent No. 4,713,808 ("Gaskill") even further in view of either U.S. Patent No. 5,394,140 ("Wong") or U.S. Patent No. 5,332,994 ("Kawashima"). Claims 7-15 stand rejected under § 103(a) as obvious over Dalvi in view of Bartee further in view of Gaskill

even further in view of either Wong or Kawashima and further in view of U.S. Patent No. 4,885,577 ("Nelson").

OPINION

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the main point of contention therebetween. The examiner makes the following assertions.

> The paging message of Dalvi includes "definable audio" (page 1 line 36). The calling party in the Dalvi system composes not only the message but also an audio compostition [sic] comprising a sequencd [sic] of audio tones using the composer 105 which could be a keyboard or a musical instrument (page 2 lines 30-35). The receiver 120 then sends the message data to the display and communicates the audio composition to th [sic] eaudio [sic] generator 220 which reproduces the audio composition at step 425 (see page 4 lines 33-35). Clearly the received message is responsible for the audio alert which is generated to indicate the message is being displayed (see figure 4).

(Examiner's Answer at 6.) The appellant argues, "Dalvi does not teach or suggest 'a melody generator which generates said alert tone . . . , said alert tone corresponding to, **and reproducing at least a portion of the musical note data** [contained within the message being received]', as required by Appellant's independent claim[s]. . . ." (Appeal Br. at 6.)

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed.

Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, independent claims 4, 7, and 8 specify in pertinent part the following limitations: "[a] radio pager for receiving from a base station a paging signal including an address code group and a message code group, said message code group including message data and musical note data, . . . said radio pager comprising . . . a melody generator which generates said alert tone in response to said coincidence, said alert tone corresponding to, and reproducing at least a portion of the musical note data separated by said controller from the message code group. . . ." Giving the independent claims their broadest, reasonable construction, the limitations require generating an alert tone reproduced from musical data coded in a paging signal.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of

obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)(citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Dalvi's radio pager generates tones reproduced from musical data coded in a paging signal. Specifically, "[t]he controller 210 . . . communicates the audio composition to the audio generator 220 which reproduces 425 the audio composition." P. 4, ll. 33-35. The reference's audio composition, however, is not an alert tone. Rather than using the audio composition to alert a user of receipt of a selective call message ("SCM"), Dalvi generates a separate alert tone. Specifically, "[u]pon successfully storing the SCM in the memory 212, the controller provides an output to the audio generator 220 causing the audio generator 220 to produce an audio alert. The audio alert informs a subscriber that the SCM 30 has been received." *Id.* at ll. 26-30.

Responsive to the audio alert, the user can then view the text of the SCM and listen to its audio composition. Specifically, "[w]hen the subscriber initiates a read message function, the controller 210 extracts the SCM from the memory 212, and thereby obtains 415 the message data and the audio composition from the SCM. The controller 210 sends the message data to the display 215, which displays the message data, and communicates the audio composition to the audio generator 220 which reproduces 425 the audio composition." *Id.* at ll. 30-35.

The examiner fails to allege, let alone show, that the addition of Bartee, Gaskill, Wong, Kawashima, or Nelson cures the deficiency of Dalvi. Absent a teaching or suggestion of an alert tone reproduced from musical data coded in a paging signal, the examiner fails to present a *prima facie* case of obviousness. Therefore, we reverse his rejections of claim 4 and claims 2, 3, 5, 6, and 13, which fall therewith; of claim 7 and claims 9, 10, and 14, which fall therewith; and of claim 8 and claims 11, 12, and 15, which fall therewith.

CONCLUSION

In summary, the rejections of claims 2-15 under § 103(a) are reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
JERRY SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037